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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,883	04/13/2000	Michael I. Watkins	2558B-061300US	7641

7590 07/24/2003

M. HENRY HEINES
TOWNSEND AND TOWNSEND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

GABEL, GAILENE

ART UNIT PAPER NUMBER

1641

DATE MAILED: 07/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/548,883

Applicant(s)

WATKINS ET AL.

Examiner

Bao-Thuy L. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 23-25, 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Applicant's amendment filed 2/20/03 has been received. Claims 26-30 have been added. Claims 1-30 are pending.
2. All rejections not reiterated herein below are withdrawn.
3. The double patenting rejection of claims 1-19 are withdrawn in view of the filing of a Terminal Disclaimer.

Election/Restrictions

4. Newly submitted claims 29-30 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 29-30 are drawn to a composition and test system and are related to the method as product and process of use. However, product can be used in a materially different process such as column chromatography, laser trapping methods or agglutination assays.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29-30 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. This application contains claims (23-25 and 29-30) drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

6. Claims 1-2, 7-15 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins et al (US 6,280,618) in view of Dietzen (US 5,795,789) and Weckermann (WO 95/02824) for reasons of record in paper no. 12.
7. Claims 20-22 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins in view of Dietzen and Weckermann as applied to claims 1-2, 7-15 and 18-19 above, and further in view of Frengen (US 5,723,346) for reasons of record in paper no. 12.
8. Claims 3 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins in view of Dietzen and Weckermann as applied to claims 1-2, 7-15 and 18-19 above, and further in view of Smith et al (US 4,332,784) for reasons of record in paper no. 12.
9. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins in view of Dietzen and Weckermann as applied to claims 1-2, 7-15 and 18-19 above, and further in view of Frieden et al (J. Biol. Chem. 1948. 176. 155-163) and Block et al (J. Med. Chem. 1976, 19(8), 1067-1069) for reasons of record in paper no. 12.

Response to Arguments

10. Applicant's arguments filed 2/20/03 have been fully considered but they are not persuasive.

Applicant argues that Watkins et al, US 6,280,618, is not prior art because the instant application and the Watkins reference are owned by or subject to an assignment to the same assignee. Applicant's attention is directed to revised 35 USC 102(e), which states:

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****>** Revised 35 U.S.C. 102(e), as amended by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)), and as further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)), applies in the examination of all applications, whenever filed, and the reexamination of, or other proceedings to contest, all patents. The filing date of the application being examined is no longer relevant in determining what version of 35 U.S.C. 102(e) to apply in determining the patentability of that application, or the patent resulting from that application. The revised statutory provisions supercede all previous versions of 35 U.S.C. 102(e) and 374, with only one exception, which is when the potential reference is based on an international application filed prior to November 29, 2000. Furthermore, the provisions amending 35 U.S.C. 102(e) and 374 in Pub. L. 107-273 are completely retroactive to the effective date of the relevant provisions in the AIPA (November 29, 2000). See MPEP § 706.02(f)(1) for examination guidelines on the application of 35 U.S.C. 102(e).<

Therefore, the application of Watkins is proper and the rejections are maintained.

Conclusion

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to

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37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gailene Gabel whose telephone number is (703) 305-0807. The examiner can normally be reached on Monday to Thursday, 6:30 a.m. - 4:00 p.m. and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703) 305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 and (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

BTN for GG
July 23, 2003


BAO-THUY L. NGUYEN
PRIMARY EXAMINER